

II. Remarks.

Upon entry of this Amendment, claims 2-9, 11 and 13-41 are pending. Claims 2, 4-9 and 13-41 stand rejected under 35 U.S.C. §112, paragraph 2, as indefinite; claims 2-9, 11, 13-19, 22-26, 28 and 31-41 stand rejected as anticipated by U.S. Patent No. 5,707,843 ("Monte '843"); and claims 20-22, 23, 27, 29-30 and 40 stand rejected as being obvious in view of U.S. Patent Nos. 5,707,843, 5,578,336 and 5,424,299, all to Monte. The Examiner has (1) still has provided no objective reasoning as to why the claims are indefinite, especially in view of the fact that the alleged indefinite terms are defined in the specification and are known to those skilled in the art, and (2) continues to assert the Monte '843 reference, despite the fact that it does not teach adding an active to a composition at the temperature at which the active would normally be denatured, but wherein some of the active is not denatured and imparts a beneficial effect to the composition.

A. Rejections Under 35 U.S.C. § 112.

The Examiner is not reading the claim terms in the context of the claim or application which they are a part. Instead, the Examiner is reading individual words in a vacuum and concluding they are indefinite based on dictionary definitions instead of considering how the words would be perceived by the skilled artisan in view of the specification. In re Moore, 169 USPQ 236, 238 (CCPA 1971) ("[T]he definiteness of the language employed must be analyzed - not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art."); Seattle Box Co., v. Industrial Crating & Packing, Inc., 221 USPQ 568 (Fed. Cir. 1984); MPEP § 2173.05 (b) (Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.) The Examiner is incorrect in assuming that Applicant is reading limitations into the claims. The limitations are already there; the only issue is their respective meanings, and those meanings are plainly set forth in context of the claims and specification.

The Examiner has misapplied MPEP § 2111. Claims are to be given their broadest reasonable interpretation. It is not reasonable for the Examiner to dissect claims, interpret words apart from the claims and specification of which the words are a part, and conclude that the words are indefinite. All of the words to which the Examiner objects are clearly defined in the specification, either explicitly or implicitly, as explained below. Yet the Examiner refuses to consult the teachings of the specification, and instead resorts to dictionary definitions.

First, the Examiner appears to be objecting to the breadth of the claimed terms. As a matter of law a rejection based upon breadth of the claim is improper and must be removed. In re Miller, 169 USPQ 597 (CCPA 1971) (Breadth of a claim is not to be equated with indefiniteness.)

Moreover, one skilled in the art readily understands what the terms to which the Examiner objects, i.e., “would,” and “actives” mean – especially given the definitions in the specification, and the Examiner has provided no objective evidence to the contrary. See Andrew Corp. v. Gabriel Electronics, 6 USPQ2d 2010 (Fed. Cir. 1988) (The court held that the limitation “which produces substantially equal E and H plane illumination patterns” was definite because one of ordinary skill in the art would know what was meant by “substantially equal.”) (emphasis added).

The Examiner objects to the use of the word “would” in the claims. “Would” is a common English word that should be given its common English meaning. Specifically, as made plain by the teachings of the specification, the invention involves, inter alia, adding an active to a composition at a temperature at which the active would normally be denatured. There is nothing indefinite about the use of “would.” The word cannot be read in a vacuum out of context with the other claim language, and the Examiner has not cited any rules or law supporting such a contention.

The Examiner further asserts that she cannot understand the term “active” because the specification does not explain what may be considered a “biologically active substance.” Yet, the specification itself plainly states that actives include “enzymes, antibodies, vitamins or a combination thereof.” Application, p. 1, ll. 11-13.

In summary, the Examiner has again provided no objective evidence as to why persons skilled in the art would not understand the words as used in the claims. Nor has the Examiner explained why the case law cited by Applicant is inapposite here.

B. Rejections Under 35 U.S.C. §§ 102 and 103.

Applicant respectfully submits that the continued rejections under 35 U.S.C. §§ 102 and 103 are inappropriate, but has amended claim 2 to perhaps better define certain aspects of the invention. The invention allows for, among other things, the addition of an active to a substance while the substance is at a temperature that would normally denature the active and, utilizing the invention, the active is not denatured. As explained in the Background and Summary of the Invention sections, this is a significant improvement over the prior art. The Examiner's continued reliance on Monte '843 is misplaced because Monte '843 does not teach, suggest or show this feature. (Applicant again notes that Monte is the inventor of the present application and thoroughly understands the difference between this invention and his prior inventions.) In fact, the Examiner does not even assert in the Office Action that Monte teaches these steps or features. The specific sections of Monte '843 cited now by the Examiner are addressed below:

1. The abstract does not even address the temperature at which an active is added to a composition.

2. Column 1, lines 21-39 merely describe a prior art method and the deficiencies thereof. 140 degrees F is below the denaturing temperature of lactase enzyme. The same prior art example is recited on page 4, lines 14-23 of the present application.

3. Column 2, lines 7-10 appear to have nothing to do with the temperature at which the active is added to the composition.

4. Column 2, lines 18-49 do not mention adding an active to a composition while the composition is at a temperature that would normally denature the active.

5. Columns 5-6 teach away from the present invention. At column 5, ll. 28-35, it states, among other things, that "[h]eating the dairy product to a pasteurization or sterilization

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temperature after the enzyme composition is added is counterproductive in practicing the invention because enzymes are deactivated at pasteurization and sterilization temperatures.”

6. Column 1, line 63 - column 2, line 13 do not teach any aspect of the claimed method to make a composition. In fact, column 1, lines 63-67 teach the provision of “an improved food composition which can, after a dairy product has been pasteurized or sterilized, be combined with a dairy product to reduce the concentration of lactose in the dairy product. Hence, this expressly teaches away from the claimed invention.

In view of the comments above, Applicant submits that the rejections under 35 U.S.C. §§ 102 and 103 are traversed.

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III. Conclusion.

In view of the amendments and arguments herein, this Application is believed to be in condition for allowance and favorable action is requested. Applicant reserves the right to prosecute additional claims, including claims of broader scope, in a continuation application.

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to **Deposit Account No. 19-3878**. Applicant further reserves the right to prosecute broader claims in this application or a continuation application

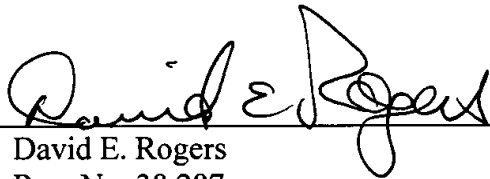
The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

April 20, 2004

Date

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